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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,031	02/19/2004	Joseph R. Eichhorn	101-03	5598

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William M. Selenke
5 Drummond St.
Cincinnati, OH 45218

EXAMINER

SMITH, RICHARD A

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/782,031

Applicant(s)

EICHHORN, JOSEPH R.

Examiner

R. Alexander Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

In this case, the examiner has cited the references on the PTO-892 form.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 126 in figure 1, 42 in figure 4 and 925 in figure 9. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being

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amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to because the element or elements to which the element number "428" points in numerous figures is unclear and needs to clearly show this element. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims 1-4 and 6 are objected to because of the following informalities:

Claim 1: "movable affixed" in line 9 should be --movably affixed--.

For claims 2-4 and 6, the word "one" in "claim one" should be --1--.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 5,103,566 to Stebe.

Stebe discloses a guide having a rail 1, said rail having an attachment end 2 and a spacer end (toward 1A), means of readily reversibly affixing said rail to said saw (via 4 and C), and a spacer 3 movably affixed at a ninety degree square to the rail.

Claim Rejections - 35 USC § 103

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,103,566 to Stebe.

Stebe discloses a guide for a power circular saw comprising a rail 1, said rail has an attachment end 2 and a spacer end (toward 1A); said attachment end has a pin 2 with a bore, reversibly attached to the workpiece is a saw attachment piece 4 which further comprises a blade part (figures 6-6C, the right side) and an attachment part (the left side); said attachment part has one or more holes; said holes complementarily reversibly receive said pin on said attachment end; a spacer 3 is movable affixed as a ninety degree square to said rail; said spacer is moveably affixed at the position on said rail to provide the desired width of the saw cut. Furthermore, Stebe discloses said spacer having a rectangular shape and that the rail and saw attachment piece are separable so that the rail can be used as a compass or as a cutting guide (figures 2 and 3).

Stebe does not disclose said attachment end having one or more bosses, wherein said holes complementary receive said bosses, and said attachment piece being permanently attached to the circular hand saw.

With respect to the bosses and the holes receiving said bosses: the use of the bosses and holes, as claimed by Applicant, is considered to be equivalent to the pin and holes, as disclosed by Stebe, since: 1) neither non-obvious nor unexpected results, i.e., results which are different in

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kind and not in degree from the results of the prior art, will be obtained if one is used instead of the other, as long as the rail can be quickly detached from the attachment piece so that the rail can be used for other purposes, as already taught by Stebe, 2) the bosses and holes claimed by Applicant and pin and holes used by Stebe are well known alternate types of connections that will perform the same function, if one is replaced with the other, of quickly and releasably connecting said rail and said attachment piece, and 3) the use of the bosses and holes is considered to be nothing more than the use of one of numerous and well known alternate types of connection means that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to quickly and releasably attach the rail and the attachment piece, as already taught by Stebe.

With respect to said attachment piece being permanently attached to the saw: Since Stebe discloses that the rail is detachable from the attachment piece so that the rail can be used as a cutting guide, as a router guide, as a compass, etc., it would be obvious to one of ordinary skill in the art at the time of the invention to leave the attachment piece attached to the saw in order to prevent loss of said attachment piece when the rail is being used for other purposes. In a broad sense, this appears to the examiner as meeting a definition of permanent, i.e., lasting or remaining without essential change in condition, status or place.

8. Claims 2, 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stebe as applied to claims 1 and 4 above, and further in view of U.S. 6,049,990 to Holland.

Stebe teaches all that is claimed as discussed in the above rejections of claims 1 and 4 except for the spacer having a T shape, an H shape and being adjustably placed at angles other than ninety degrees.

Holland discloses a spacer attached to a rail wherein the spacer has a T-shape and the spacer is adjustable at angles other than ninety degrees. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add the T-shape and the angles, as taught by Holland, to the guide, taught by Stebe, in order to allow the measurement of angles, to allow scribing, cutting or marking lines at angles and to provide the T-shape to provide a secure hold of the spacer on the rail so the spacer will stay in position at ninety degrees.

With respect to the H-shaped spacer: the spacer having an H-shape is only considered to be an obvious modification of a spacer shape because the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide. In re Dailey, 149 USPQ 47 (CCPA 1976).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related guides.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Alexander Smith whose telephone number is 571-272-2251.

The examiner can normally be reached on Monday through Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. Alexander Smith', is positioned above the printed name and title.

R. Alexander Smith
Patent Examiner
Technology Center 2800

RAS
November 29, 2004